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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,216	03/29/2004	Luke Aram	1671-0295	3037
28/078 7590 01/08/2010 MAGINOT, MOORE & BECK, LLP CHASE TOWER 111 MONUMENT CIRCLE SUITE 3250 INDIANAPOLIS, IN 46204				
EXAMINER				
ARAJ, MICHAEL J				
ART UNIT		PAPER NUMBER		
3775				
MAIL DATE		DELIVERY MODE		
01/08/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,216

Applicant(s)

ARAM ET AL.

Examiner

MICHAEL J. ARAJ

Art Unit

3775

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-36 is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-14 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The arguments filed on December 23, 2008 have been partially persuasive. A non-final rejection follows below:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the opposite side" in lines 4 and 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the saw" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the saw guides" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the opposite side" in lines 4 and 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the block" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the opposite side" in lines 4 and 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the saw" twice in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the saw guides" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the block" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the opposite side" in lines 9-10. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the saw" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the saw driver" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the saw driver" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "the finger" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "the second finger" twice in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "the second finger" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8, 9, 12, 13 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mains et al. (U.S. Patent No. 4,421,112) in view of Haines (U.S. Publication No. 2006/0030854).

Mains et al. (herein Mains) discloses a guide system comprising: a first and second alignment pin (12); and wherein the first and the second alignment pin (12) are configured and oriented to define a resection of reference (col. 2, lines 8-38). The first and second alignment pin (12) has a length sufficient that the first and second alignment pin (12) extends completely through the bone with one tip extending beyond the bone on the first side and the second tip extending beyond the bone on an opposite side (col. 4, lines 27-33). The resection surface of reference is a plane (col. 4, lines 57-68). The apparatus further comprises a guide block formed to include a first and second guide hole (col. 2, lines 51-54). The first and second guide hole being sized to receive a drill sized to form a hole in the sized to receive the first and second alignment pin. The second guide hole oriented with respect to the first guide hole to define a plane (col. 2, lines 54-67). The guide block is formed to include a first and a second guide saw guide (see Figure 1 below). The first alignment pin (12) is received in the bone and the first

guide hole and the second alignment pin (12) is received in the bone and the second guide hole (col. 5, lines 4-34). The guide block is formed to include a third guide hole extending through the guide block, sized to receive a drill sized to form a hole, and a third alignment pin (col. 3, lines 35-44). The apparatus further comprises a saw driver (col. 5, lines 48-49).

Mains disclose the claimed invention except for the wire saw; a saw driver configured to be guided by the first pin through the bone and to drive the saw guided by the saw driver and the second alignment pin through the bone. Haines teaches to provide a cutting wire having sufficient tensile strength when drawn into a small diameter in order to present a thin cutting profile. Haines also discloses the saw being guided from a first pin to a second pin (see Fig. 61). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Mains having a wire saw, in view of Haines, in order to reduce implant placement errors in order to create more reproducible and consistently excellent clinical results that is less dependent on manual skills of the surgeon (Paragraph 13).

With respect to claims 19-21, Mains et al. and Haines discloses the claimed invention except for the first and second alignment pins and the wire saw being configured to be inserted through incisions less than six centimeters long; less than about two centimeters long; and about one centimeter long. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Mains with the first and second alignment pins configured to be inserted through incisions less than six centimeters long, less than about two centimeters long

and about one centimeter long, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Allowable Subject Matter

Claims 6, 7, 10, 11 and 14-17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 30-36 are allowed.

Response to Arguments

Applicant's arguments, see appeal brief, filed December 23, 2008, with respect to claim 30 have been fully considered and are persuasive. The rejection of claim 13 has been withdrawn and is considered to be allowable because Hitt does not disclose the claimed element of this claim 30, specifically a river that is separate from a wire saw to include bone cutting teeth on one end of the body.

Additionally, claims 6, 7, 10, 11 and 14-17 do not appear to be contained in the prior art of record. As stated above the appear to be in condition for allowance once the issues under 35 U.S.C. 112, 2nd paragraph have been overcome and include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. ARAJ whose telephone number is (571)272-5963. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J Araj/

Examiner, Art Unit 3775

/Thomas C. Barrett/

Supervisory Patent Examiner, Art Unit 3775